

Remarks/Arguments

Applicants request that the present application be reconsidered. Claims 1-31 remain in the application for consideration. The Office Action rejected claims 1-15, 17-22, 30 and 31 under 35 U.S.C. § 101 because the rejected claims allegedly do not recite technology in a non-trivial manner. The Office Action also rejected claims 1-31 pursuant to 35 U.S.C. § 103 (a) as being unpatentable over the combination of Todorov (U.S. Patent No. 6,564,247) (hereinafter the Todorov patent), Petreley et al. “Benchmark test serves up Secondhand Tomatoes and Argyle Toast,” InfoWorld, July 5, 1993, (hereinafter the Petreley article), and Klug et al. (U.S. Patent No. 5,790,785) (hereinafter the Klug patent). As discussed below, Applicants respectfully traverse these rejections.

Section 101 Rejections

The Office Action rejected claims 1-15, 17-22, 30 and 31 under 35 U.S.C. § 101. Applicants have amended independent claims 1, 17, 30 and 31 to clarify that the methods claimed are implemented in a computing environment. Thus, the amended claims each recite a method that is implemented in a computing environment for producing a unique account name that is provided to a user. The specification describes an exemplary computing environment in which the methods may be implemented.

The Supreme Court has construed Section 101 broadly noting that Congress intended statutory subject matter to “include anything under the sun that is made by man.” *Diamond v. Chakrabarty*, 447 U.S. 303, 309 (1980). Additionally, and pertinent to the present application, the courts have stated that to be statutory a claimed computer-related process either (1) must result in a physical transformation outside the

computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan or (2) must be limited to a practical application within the technological arts. *See Diamond v. Diehr*, 450 U.S. 175, 183-84 (1981). The amended claims clearly relate to a practical application within a technological art and, as such, recite statutory subject matter. Claims 2-15 and 18-22 depend from independent claims 1 and 17 as amended respectively and, therefore, these claims also now recite statutory subject matter. Accordingly, Applicants respectfully request that the rejections based on Section 101 be withdrawn.

Section 103 Rejections

The Office Action rejected all 31 claims in this application stating that the claims are obvious in light of the combination of the Todorov patent, the Petreley article and/or the Klug patent. Contrary to the assertions in the Office Action, there is no motivation found within the prior art to combine the cited references. Moreover, even if combined, the cited references, taken as a whole, do not teach or suggest all of the limitations of the subject claims and there is no motivation from the prior art to modify the references to include the missing limitations. Therefore, Applicants respectfully traverse this rejection.

The Todorov Patent

The Todorov patent relates to an automated process for registering user identifiers (IDs) in a distributed system. Stated generally, the Todorov patent discloses a method that begins with entering certain information for a new user account, such as a person's name and a profile name, into a Request for Service (RFS) database. A request

document is then sent for approval. Next, the approved request documents are copied from the RFS database to an ID creation database where they are sorted. Thereafter, based on information contained in the request document and in a "profile document," a user ID file and an associated person document are created.

The Todorov patent does not disclose the specific content of a user ID or any detailed information relating to how a specific user ID is created. The Todorov patent does disclose generating a random initial password and discusses a recommended format for such a password (upper and lower case letters, at least one numeric symbol, at least eight symbols in length). The Todorov patent also discloses generating a unique "short name," which is an alias of the actual user name, and discusses how the short name could follow the first letter of the first name and first seven letters of the last name format. The Todorov patent states that an ID file name could also follow the short name format. The Todorov patent does not disclose that the generated IDs or passwords are provided to users for approval.

The Klug Patent

The Klug patent relates to a system for assisting World Wide Web users in registering at web sites. Generally, the system disclosed in the Klug patent allows a user to supply registration information to a repository and submits the stored information substantially automatically to web sites to which the user desires to register. The Klug system seeks to establish a common ID and password for all of the web sites the user wants to join. Initially, the user inputs a candidate ID and password. If the candidate ID and password are acceptable, they become the common ID and password. If the

candidate ID and password are unacceptable (for example, if they are a duplicate of another user's common ID and password), the Klug system provides the user with one or more alternatives, which may be derived from the registration information provided by the user, that the user may then accept or reject.

The Petreley Article

The Petreley article describes a benchmark test performed by the authors. The article states that the authors built a data generator that randomly selected unique combination of words to create realistic part names. The part names, however, are not generated in response to a request from a user and are not provided to a user for acceptance.

There Is No Motivation Found Within The Prior Art To Combine The Cited References

“Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.” *Carella v. Starlight Archery*, 804 F.2d 135, 231 U.S.P.Q. 644 (Fed. Cir. 1986). Stated another way,

If the invention is different from what is disclosed in one reference, but the differences are such that combination with another reference would lead to what is claimed, the obviousness question then requires inquiry into whether there is reason, suggestion, or motivation to make that combination.

Pro-Mold and Tool Co., Inc. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 37 U.S.P.Q.2d 1626 (Fed. Cir. 1996).

Initially, it should be noted that throughout the Action it is asserted that the Todorov patent discloses the claimed invention except for certain limitations that are disclosed in the Petreley article and/or the Klug patent. In particular, the Action asserts that the Petreley article discloses a data generator that randomly selects unique combinations of words to create realistic part names that are functional as account names and that the Klug patent discloses utilizing user-supplied information as a seed for generating an acceptable user ID, presenting the user with the newly generated ID, and providing the user with the option to accept or reject the generated information.

Despite the assertions made in the Action, it is clear that there is no motivation in the prior art to combine the disclosure in the Todorov patent with the teachings of the Petreley article or the Klug patent in the manner suggested by the Action. The Todorov patent does not teach or suggest any interaction with actual users other than accepting generally biographical information from the users and, thereafter, providing the users with an ID. Notably, it is clear from the teachings of the Todorov patent that the actual ID and other pertinent items are simply assigned to the users without any input from the users except for the initial request. The users simply are not afforded the opportunity to approve or accept their IDs or other items. Moreover, it is clear that the teachings of the Todorov patent are such that user approval is not desired or necessary because including steps to obtain the approval would significantly increase the time needed to generate the IDs and other items and, therefore, defeat the object of the Todorov patent. Thus, the teachings of the Klug patent that relate to presenting the user

with a newly-generated ID and providing the user with the option of accepting or rejecting the generated information are not combinable with the Todorov patent.

As stated above, the Todorov patent does state that passwords and short names are generated and provides that the passwords may include random combinations of letters and numbers and that the short names may be a combination of the user's first initial and the first seven letter of the user's last name. Notably, neither of these two processes includes using word elements, and in particular word elements found in a list or a database. In fact, the only specifics provided (i.e., about passwords and short names) actually teach away from utilizing words. Thus, there is no motivation to include in the Todorov patent a data generator such as the one described in the Petreley article because apparently none of the items generated in the Todorov patent include actual words. There is no motivation to include the seeding that is generally described in the Klug patent for the same reason.

For the reasons stated, clearly there is nothing from the prior art that teaches, suggests or motivates the proposed combination of the references. Therefore, it is improper to use a combination of these references to reject the claims in the present application. Thus, Applicants respectfully traverse the rejection of claims 1-31 based on Section 103 on the ground that the references are not properly combinable.

The Cited References, Taken As A Whole, Do Not Teach Or Suggest All Of The Limitations Of The Subject Claims

Even if the cited references were somehow combinable, the proposed combination still does not teach or suggest all of the limitations contained in the

Applicants' claims. Independent claims 1 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of the Todorov patent, the Petreley article and/or the Klug patent. With regard to these claims, the cited references do not teach or suggest selecting a word element from a list of word elements and combining the word element with a requested account name, which is provided by the user, to produce a modified account name. The Action admits that the Todorov patent does not teach or suggest these limitations. The Petreley article merely describes a data generator that "randomly selects words;" there is no teaching or suggestion in the Petreley article that a selected word may be combined with requested account name. If anything, the Petreley article teaches away from combining a random word with a requested account name. The Klug patent discusses only utilizing a seed derived from information provided by the user to generate ID or passwords; it does not teach or suggest utilizing a word element from a list of word elements. The combination of the cited references, therefore, does not teach or suggest all of the limitations of claim 1 or 16 and, therefore, Applicants respectfully assert that these claims are patentable over the cited references and respectfully request withdrawal of the Section 103 rejection of independent claims 1 and 16.

Claims 2-15 depend from claim 1. Thus, for at least the reasons stated above with respect to claim 1, Applicants respectfully submit that claims 2-15 are patentable over the cited references. Accordingly, Applicants respectfully request withdrawal of the rejections of dependent claims 2-15.

Independent claims 17 and 23 also stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of the Todorov patent and the Petreley article

and/or the Klug patent. The cited references, however, do not teach or suggest selecting a first word element from a database that includes a list of word elements, selecting a second word element from the database, and combining the words to produce a random account name. The Action admits that the Todorov patent does not teach or suggest these limitations. The Petreley article describes a data generator that “randomly selects words.” The article does not teach or suggest where the words are sent from. The Klug patent discusses utilizing a seed derived from information provided by a user to generate ID or passwords; it does not teach or suggest utilizing a word element from a database that includes a list of word elements. Thus, the proposed combination of the cited references fails to achieve the invention of claims 17 or 23, and Applicants respectfully request withdrawal of this rejection.

Claims 18-22 depend from claim 17. For at least the reasons stated above with respect to claim 17, Applicants respectfully submit that claims 18-22 are patentable over the cited references. Accordingly, Applicants respectfully request withdrawal of the rejections of dependent claims 18-22.

Independent claim 24 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of the cited references. The cited references, however, do not teach or suggest a database component that contains a list of word elements and a list of existing account names or a name generating component that selects word elements from the list and combines those word elements with requested account names to produce modified account names. The Action admits that the Todorov patent does not teach or suggest these limitations. The Petreley article merely describes a

data generator that “randomly selects words;” there is no teaching or suggestion in the Petreley article that a selected word may be combined with a requested account name. If anything, the Petreley article teaches away from combining a random word with a requested account name. The Klug patent discusses only utilizing a seed derived from information provided from a user to generate ID or passwords. Thus, the proposed combination of the cited references does not achieve the invention of claim 24, and Applicants respectfully request withdrawal of this rejection.

Claims 25-29 depend from claim 24. For at least the reasons stated above with respect to claim 24, Applicants respectfully submit that claims 25-29 are patentable over the cited references. Accordingly, Applicants respectfully request withdrawal of the rejections of dependent claims 25-29 as well.

Independent claim 30 stands rejected under 35 U.S.C. § 103 (a) as being unpatentable over the combination of the Todorov patent, the Petreley article and/or the Klug patent. None of the cited references teach or suggest utilizing multiple solution sets to produce a listing of unique account names with the solution sets providing an account name produced by combining a requested account name and a single- or multi-digit numerical seed or by pre-pending an adjective from a list of words to the requested account name or by combining two word elements selected from two different word lists. The Action admits that the Todorov patent does not teach or suggest these limitations. The Petreley article describes a data generator that “randomly selects words;” there is no teaching or suggestion in the Petreley article that the data generator may select numbers (whether the numbers are “seeds” or not) or that a selected word may be combined with a

word that is provided by a user. If anything, the Petreley article teaches away from combining a random word with a requested account name. The Klug patent does discuss utilizing a “seed” to generate an ID or a password. The only seed mentioned, however, is derived from information provided by the user. Thus, the Klug patent does not teach or suggest seeding with a number or numbers, combining a word that is not related to the information provided by the user, or combining a word with a number. Thus, the combination of the cited references does not achieve the invention of claim 30, and Applicants respectfully request withdrawal of this rejection.

Independent claim 31 also stands rejected under 35 U.S.C. § 103 (a) as being unpatentable over the combination of the Todorov patent, the Petreley article and/or the Klug patent. Despite the Action’s assertions to the contrary, none of the cited references teach or suggest either limitation of claim 31. In particular, as discussed above, the Todorov patent contains no teachings or suggestions wherein a user is provided with the ability to select his or her ID. The Petreley article clearly has no application to this claim. Finally, like the Todorov patent, the Klug patent does not teach or suggest providing an ID or password that is not based on information provided by the user. Instead, the Klug patent teaches allowing the user to provide these items, and, if the items are unsuitable, deriving new items from the information already provided by the user. Thus, the combination of the cited references does not achieve the invention of claim 31, and Applicants respectfully request withdrawal of this rejection.

There Is No Motivation From The Prior Art To Modify The References To Include The Missing Limitations

Finally, there is no suggestion or motivation from the prior art to modify the proposed combination of cited references to include the missing limitations indicated above. In particular, there is no suggestion or motivation to modify the Todorov patent to include steps involving selecting a word element from a list of word elements and combining the word element with a requested account name to produce a modified account name. There is also no suggestion or motivation to modify the Todorov patent to include steps for selecting a first word element from a database that includes a list of word elements or a second word element from the database and combining the words to produce a random account name. In addition, there is also no suggestion or motivation to modify the Todorov patent to include a database component that contains a list of word elements and a list of existing account names or a name generating component that selects word elements from the list and combines those word elements with requested account names to produce modified account names. There is also no suggestion or motivation to modify the Todorov patent to include steps for utilizing multiple solution sets to produce a listing of unique account names with the solution sets providing an account name produced by combining a requested account name and a single- or multi-digit numerical seed or by pre-pending an adjective from a list of words to the requested account name or by combining two word elements selected from two different word lists or the limitations found in claim 31. Thus, Applicants traverse the rejection for claims 1-31 for this reason as well and respectfully request its withdrawal.

Conclusion

In view of the foregoing, it is submitted that the present application is in a condition for allowance and such allowance is respectfully requested. Should any unresolved issues remain, please feel free to contact the undersigned at the phone number listed below. Although Applicants believe that this amendment does not require the payment of a fee, the Commissioner is hereby authorized to charge any amount associated with this amendment to Deposit Account No. 19-2112.

Respectfully submitted,

Christopher J. Eaton

Christopher J. Eaton
Reg. No. 51,143

SHOOK, HARDY & BACON L.L.P.
2555 Grand Blvd.
Kansas City, Missouri 64108-2613
(816) 474-6550